IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Safko)   Art Unit: 2154
)
Serial No.: 09/665,368)   Examiner: Chang
)
Filed: September 19, 2000)   **1173.001**
)
For: SYSTEM AND METHOD FOR PROVIDING PAPER)   April 8, 2004
MODELS OVER A WIDE AREA COMPUTER)   750 B STREET, Suite 3120
NETWORK)   San Diego, CA 92101
)

APPEAL BRIEF

This appeal brief is submitted under 35 U.S.C. §134. This appeal is further to Appellant's Notice of Appeal filed herewith.

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(1)   Real Party in Interest

The real party in interest is the inventor.

(2)   Related Appeals/Interferences

No other appeals or interferences exist which relate to the present application or appeal.

(3)   Status of Claims

Claims 1-9 and 11-17 are pending. Claim 9 as now amended incorporates the limitations of now-canceled Claim 10, which has been finally rejected along with the other claims.

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(4)   Status of Amendments

An amendment moving the limitations of dependent Claim 10 into Claim 9 and canceling Claims 18 and 19 has been submitted. Since this amendment places the application in better condition for appeal by simply moving limitations from a dependent claim into an independent claim, for purposes of this appeal brief it will be presumed to have been entered.

(5)   Summary of Invention

Using Claim 1 as an example, the invention is a method for providing paper models that includes allowing a user to access a computer site on a wide area computer network, and providing, on the computer site, at least one model page. The method also includes permitting the user to access the model page. The user can print a data file from the model page. The data file is useful for causing a computer printer to print a substrate having model indicia thereon. The model indicia is useful for configuring the substrate into a paper model.

(6)   Issues

Whether the claims are unpatentable under 35 U.S.C. §103 as being obvious over Hess et al. in view of Matos.

(7)   Grouping of Claims

The rejected claims are grouped together.

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(8)   **Argument**

The error in the rejection is easy to understand and will be dealt with succinctly. To sum up, combining the references as proposed would not result in the present claims. At most, the proposed combination would only allow a user to place a purchase order for a model using the Internet and then having the paper model substrate conventionally shipped, whereas the present independent claims recite that the information necessary for the model itself can be downloaded from the Internet and printed onto a substrate for rendering into a model.

More specifically, the claims have been rejected under 35 U.S.C. §103 as being unpatentable over eBay's Hess et al. patent, used as a teaching of "providing models" over the Internet, in view of Matos, used as a teaching of paper models. The rejection makes the classic mistakes of proposing a combination that would not in fact result in the present claims, and furthermore one that is unsupported by the requisite *prior art* suggestion to combine. Accordingly, Applicant respectfully asserts that a prima facie case of obviousness has not been established under MPEP §2142 *et seq.*

First, consider what the relied-upon sections of Hess et al. teach. Col. 5, lines 1-20 and col. 10, lines 1-32 mention that either a list of items to be sold or thumbnails of the items may be presented, to allow a buyer to preview the items. At col. 4, lines 7-22 Hess et al. does indeed disclose a server and a user computer communicating over a wide area network as alleged in the rejection, but nowhere does Hess et al. teach that the thumbnails may represent "models", much less that the thumbnails can be downloaded and then printed onto a substrate that can be rendered into the items that the thumbnails actually represent. Instead, what Hess et al. actually teaches at col. 7, line 61-col. 8, line 30 (alleged to be a teaching of providing files representing models) is merely that files representing *images* of items to be sold may be downloaded, not that

the files represent "models", much less that printing the files onto substrates facilitates rendering the

substrates into models.   In fact, apart from twice mentioning a "client-server model" to refer to its system

architecture, Hess et al. nowhere mentions the word "model", and clearly not as a type of item to be vended.

To the extent that the examiner is construing the thumbnail images of Hess et al. as being the claimed

"model" under the guise of broad claim interpretation during prosecution, MPEP §2111.01 does not permit

any broad interpretation to be accorded to a claim term, but rather *only* those interpretations that would be

accorded by the skilled artisan.   Evidence has been seasonably requested showing that, to the skilled artisan,

thumbnail images are synonymous with "models", but it has not been provided.

In any case, what is downloaded when the user clicks on a thumbnail image in Hess et al. is not the

advertised item itself, but rather information about the item.   Contrast this to Claim 1, for instance, which

requires that a user not only access a model page, but also print a data file from the page that is useful for

causing a computer printer to print a substrate having model indicia thereon, with the model indicia in turn

being useful for configuring the substrate into a paper model.   The rejection alleges that this limitation is

taught by Hess et al. at col. 3, lines 24-29 and col. 8, lines 29-54, but this is a misrepresentation of what

Hess et al. actually teaches, which is simply that thumbnails of various image formats may be downloaded.

Nothing in Hess et al. mentions "models", much less that what is downloaded when a user clicks on a

thumbnail is a file that can be printed onto a substrate for actual rendition of the substrate into something,

much less a model, as set forth in Claim 1.

This deficiency in the rejection is important because an accurate portrayal of what Hess et al. teaches

makes evident that combining Matos with Hess et al. does not result in the present invention.   Instead, all

the proposed combination would result in would be downloading *thumbnails* showing Matos' model, not

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downloading a data file that would be useful, as required in Claim 1, to configure a paper substrate into an actual model. Accordingly, the proposed combination would not arrive at, e.g., Claim 1, rendering the *prima facie* case defective under the MPEP.

Second, the proposed combination lacks the requisite prior art suggestion and thus is traversed on this additional ground, see, e.g., MPEP §2143.01 (the mere fact that a reference <u>can</u> be modified does not render an invention obvious, unless the modification is suggested by the prior art, citing <u>In re Mills</u>). As divulged above, Hess et al. nowhere envisions paper models, so it cannot provide the motivation to use Matos. Matos teaches folding picture puzzles but nowhere mentions how they may be obtained, much less does Matos suggest obtaining them over a wide area network.

Sensing that providing a rationale for combining two references is required but evidently unaware of the constraint that the rationale must come from the prior art, the rejection alleges that the proposed combination is proper simply because "Matos' paper model would improve images of Hess' system by folding the pieces of paper to construct a three dimensional image structure", Office Action, paragraph 5. Apart from springing from the imagination of the examiner and not from the prior art, this rationale, as far as it is comprehensible, appears to be based on a *non-sequitur*. How, precisely, does a foldable paper model improve a computer thumbnail image? What is the mode of improvement by which the proposed cooperation of paper with electronic images operates? Why, precisely, would eBay need to provide foldable paper models to communicate the intended product information to a Web surfer? The rejection falls because there exists no prior art reason to combine Matos with Hess et al.

The examiner has responded to some of the points above in a puzzling way, namely, by referring to portions of the present specification to allege that Hess et al. is "relevant prior art" and that in some strange

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way this validates the rejections.   However, Appellant has not argued non-analogousness of the prior art.

Regardless of whether Hess et al. is analogous, the point remains that (1) the proposed combination would

not arrive at the present claims, but only at what the references actually teach, namely, the ability to order

a model over the Internet but not the ability to download files that can be printed and rendered into the actual

models, and (2) in any case, the references do not provide the requisite *prior art* suggestion to combine.

Respectfully submitted,

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APPENDIX A - APPEALED CLAIMS

1.   A method for providing paper models, comprising:
allowing a user to access a computer site on a wide area computer network;
providing, on the computer site, at least one model page;
permitting the user to access the model page; and
permitting the user to print at least one data file from the model page, the data file being useful for causing a computer printer to print a substrate having model indicia thereon, wherein the model indicia is useful for configuring the substrate into a paper model.

2.   The method of Claim 1, wherein the data file is further useful for causing the computer printer to print assembly instructions for the paper model.

3.   The method of Claim 1, further comprising the act of:
generating accounting data when the user accesses the model page.

4.   The method of Claim 1, further comprising the act of:
generating accounting data when the user prints the data file.

5.   The method of Claim 4, further comprising the act of:
generating accounting data when the user accesses the model page.

6.   The method of Claim 1, further comprising the act of:
providing at least one hyperlink to the model page, whereby the user accesses the model page by clicking on the hyperlink.

7.   The method of Claim 1, further comprising the act of:
presenting an image of at least a portion of an object on the model page.

8.   The method of Claim 7, wherein the user prints the data file at least in part by clicking on the image on the model page.

9.   A system for providing paper models, comprising:
at least one user computer; and
at least one model server, the user computer communicating with the model server via a wide area computer network, the model server including a module including means for providing files representing paper models to the user computer via the wide area computer network, wherein the means for providing paper models comprises:
means for permitting the user to access a model page; and

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means for permitting the user to print at least one data file using the model page, the data file being useful for causing a computer printer to print a substrate having model indicia thereon, wherein the model indicia is useful for configuring the substrate into a paper model.

11.   The system of Claim 10, wherein the data file is further useful for causing the computer printer to print assembly instructions for the paper model.

12.   The system of Claim 10, wherein the means for providing paper models further comprises: means for generating accounting data when the user accesses the model page.

13.   The system of Claim 10, wherein the means for providing paper models further comprises: means for generating accounting data when the user prints the data file.

14.   The system of Claim 13, wherein the means for providing paper models further comprises: means for generating accounting data when the user accesses the model page.

15.   The system of Claim 10, wherein the means for providing paper models further comprises:
        means for providing at least one hyperlink to the model page, whereby the user accesses the model page by clicking on the hyperlink.

16.   The system of Claim 10, wherein the means for providing paper models further comprises:
        means for presenting an image of at least a portion of an object on the model page.

17.   The system of Claim 16, wherein the user downloads the data file at least in part by clicking on the image on the model page.